

REMARKS

This communication is a full and timely response to the final Office Action dated September 8, 2003, the period for response being extended three-months through a Request for Three-month Extension of Time filed concurrently herewith. By this communication, claim 1 has been amended to recite storage means for storing correction patterns on a plurality of contact lenses, each correction pattern having a different far vision and near vision zone pattern, calculation means for retrieving correction pattern data, and determining a correction pattern for the patient's eye based on the retrieved correction pattern data and obtaining ablation control data based on the determined correction pattern. Support for the amendment to claim 1 can be found variously throughout the specification. For example, support for the changes to claim 1 can be found in the specification at page 17 line 25 through page 18 line 27, page 19 line 11 through page 20 line 9.

In addition, claim 2 has been amended to recite the calculation means retrieves the correction pattern data stored in the storage means with reference to the inputted identifier. Support for the amendment to claim 2 can be found variously throughout the specification. For example, support for the changes to claim 1 can be found in the specification at page 17 line 25 through page 18 line 27. Claims 3 and 5 have been amended to maintain consistency with amended claim 1. Claim 6 has been amended to recite a process in which a first contact lens for providing the patient's eye with refractive power of a first correction pattern having a first far vision and near vision zone pattern, which corresponds to the obtained data on prescription is prepared; and a second contact lens for providing the patient's eye with refractive power of a second correction pattern having a second far vision and near vision zone pattern, which is different from the first correction pattern. Support for the changes to claim 6 can be found variously throughout the specification, for example, at page 16 line 19 through page 17 line 24. Claim 8 has been amended to recite a storage unit which stores correction patterns on a plurality of kinds of contact lenses, each correction pattern having a different far vision and near vision zone pattern; and a calculation unit which retrieves correction pattern data. Support for the changes to claim 8 can be found variously throughout the specification, for example, at page 17 line 25 through page 18 line 27, and page 19 line 11 through page 20 line 9.

Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does

not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of this amendment is respectfully requested. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Applicant submits that no new matter has been added. Claims 1-3 and 5-10 are currently pending where claims 1, 6, and 8 are independent.

Rejections Under 35 U.S.C. §112

Claims 1-5 were rejected under 35 U.S.C. § 112 second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution of the instant application claims 1 and 3 have been amended to recite "determine correction pattern" as suggested by the Examiner. For at least this reason, Applicant respectfully requests that rejection of claims 1-5 under §112 second paragraph be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 1-10 were rejected under 35 U.S.C. §103(a) as unpatentable over *Amano et al.*, U.S. Patent No. 6,190,374 in view of *Lieberman et al.*, U.S. Patent No. 6,416,179. Applicant respectfully traverses this rejection.

Claim 1 recites a corneal surgery apparatus for correcting a refractive error by ablating corneal tissue of a patient's eye with a laser beam comprising laser irradiation means for irradiating the laser beam onto a cornea of the patient's eye; storage means for storing correction patterns on a plurality of kinds of contacts lenses, each correction pattern having a different far vision and near vision zone pattern; and calculation means for retrieving correction pattern data on a contact lens for a trial use corresponding to data on prescription provided to the patient's eye, determining a correction pattern for the patient's eye based on the retrieved correction pattern data and obtaining ablation control data based on the determined correction pattern.

Claim 6 recites a correction data determining method of correcting a refractive error by ablating corneal tissue of a patient's eye with a laser beam comprising a process in which an ophthalmic examination of the patient's eye including a refractive power inspection is performed, and data on prescription provided to the patient's eye is obtained; a process in which a first contact lens for providing the patient's eye with refractive power of a first correction pattern having a first far vision and near vision zone pattern, which corresponds to the obtained data on prescription is prepared; a process in which the first contact lens is put on the patient's eye for a trial use and a result of the trial use is checked to see whether is good or bad; and a process in which, if the trial use of the contact lens bears a good result, a correction pattern for the patient's eye is determined based on the first correction pattern, and if the trial use of the first contact lens bears a bad result, a second contact lens for providing the patient's eye with refractive power of a second correction pattern having a second far vision and near vision zone patter, which is different from the first correction pattern, is put on the patient's eye for a trial use, and the correction pattern for the patient's eye is determined based on a correction pattern of a contact lens which bears a good result.

Claim 8 recites a corneal surgery apparatus for correcting a refractive error by ablating corneal tissue of the patient's eye with a laser beam comprising an ablation unit which comprises a laser light source emitting a laser beam and an irradiation optical system for irradiating the emitted laser beam onto a cornea of the patient's eye; a storage unit which stores correction patterns on a plurality of kinds of contact lenses, each correction pattern having a different far vision and near vision zone pattern; and a calculation unit which retrieves correction pattern data on a contact lens for a trial use corresponding to data on prescription provided to the patient's eye, determines a correction pattern for the patient's eye based on the retrieved correction pattern data and obtains ablation control data based on the determined correction pattern.

Amano discloses an apparatus for operating upon a cornea for correcting not only hypermetropia or myopia but also presbyopia. However, *Amano* only teach a correction optical system for correcting myopia, hypermetropia and presbyopia, and a method of ablation by controlling the correction optical system. The Office Action acknowledges that *Amano* fails to disclose, teach, or suggest at least that corneal correction is determined by fitting the patient's eye with a contact lens.

Lieberman disclose a method for diagnosing, analyzing, or treating a cornea. According to *Lieberman*, a moldable mask such as collagen is molded on the cornea with a contact lens having a posterior surface conforming to a corrected surface model of the cornea, and the corneal shape is corrected by ablating the masked cornea uniformly until all portions of the mask are removed. That is to say, the contact lens taught by *Lieberman* is for forming a mask for uniform ablation and optical characteristics of the contact lens is not utilized for determination of a pattern for correcting a patient's eye. Further, *Lieberman* teaches that one method for forming the cornea according to the correction pattern after the correction pattern is determined by a certain inspection, and it is totally different from an aperture or a method of the present invention, of which characteristic resides in the process of determining the correction pattern. In other words, in the contact lens taught by *Lieberman* the posterior surface is in a shape of the cornea after laser ablation and it merely functions as a molding box for forming the moldable mask. *See* Fig. 8. Furthermore, the contact lens does not have a characteristic of the contact lens, as recited in claims 1, 6, and 8 that is capable of performing the refractive correction of the eye. Moreover, *Lieberman* fails to disclose, teach, or suggest the use of presbyopic correction.

Regarding the combination of *Amato* and *Lieberman* rendering the claimed subject matter obvious, the Office Action alleges, “[t]his is due to the fact that visual defects of the eye are determined prior to irradiation for correcting refractive errors or any ophthalmic surgery. It is also common to use different lenses during ophthalmic examination so as to determine the visual effects of the eye in order to prescribe correction data to a patient's eye (i.e., contact lenses, eye glasses, or refractive surgery).” *See* page 5 item 8. The process described by the Office Action is akin to that performed by a subjective refractive power measurement apparatus in the process of determining corrective diopters. In using a subjective refractive power measurement apparatus, an eye to be examined is applied with one or several lens(es) having spherical or astigmatic corrective diopters. If, as alleged, the device used in *Lieberman* is equivalent to a subjective refractive power measurement apparatus, then the need to use the apparatus of claims 1 and 8 or perform the method of claim 6 would be obviated because the problem would already be corrected. Accordingly, *Lieberman* fails to disclose, teach, or suggest a method for applying a contact lens that includes a correction pattern for actual confirmation. Therefore, a *prima facie* case for obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the reasons discussed above, Applicant respectfully requests that the rejection of claims 1, 6, and 8 under 35 U.S.C. §103 be withdrawn and these claims be allowed.

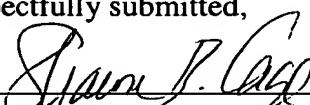
Claims 2, 3, and 5 depend from claim 1, claim 7 depends from claim 6, and claims 9 and 10 depends from claim 8. By virtue of this dependency, Applicants submit that claims 2, 3, 5, 7, 9, and 10 are allowable for at least the same reasons given above with respect to their respective base claims. In addition, Applicants submit that claims 2, 3, 5, 7, 9, and 10 are further distinguished over *Amato* and *Lieberman* by the additional elements recited therein, and particularly with respect to each claimed combination. Applicants respectfully request, therefore, that the rejection of claims 2, 3, 5, 7, 9, and 10 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants submit that claims 1-3 and 5-10 are allowable, and this application is in condition for allowance. Accordingly, Applicants request favorable reexamination and reconsideration of the application. In the event the Examiner has any comments or suggestions for placing the application in even better form, Applicants request that the Examiner contact the undersigned attorney at the number listed below.

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Respectfully submitted,

By 

Ronald P. Kananen
Registration No.: 24,104

Shawn B. Cage
Registration No.: 51,522
Attorneys for Applicant

RADER, FISHMAN & GRAUER, PLLC
Lion Building
1233 20th Street, N.W., Suite 501
Washington, D.C. 20036
Tel: (202) 955-3750
Fax: (202) 955-3751
Customer No. 23353

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